

housing; an electrically conductive liquid medium filling said enclosure, said electrically conductive liquid medium having an effective amount of a catalyst to suppress formation and/or promote recombination of gases formed as a result of said high voltage electrical spark discharge.

THE REJECTIONS UNDER 35 USC § 112

The newly presented claims are believed to render the claim objections and the rejection under 35 U.S.C. 112, second paragraph moot.

THE REJECTIONS UNDER 35 USC § 103

Claims 1-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Uebelacker U.S. Patent No. 5,458,652 in view of Pavelle et al. U.S. Patent No. 4,968,395. Withdrawal of the rejection is respectfully traversed. The Examiner states that Uebelacker teaches a process and a device for generating shock waves for medical uses by means of a spark gap formed between two electrodes mounted in a liquid medium (col. 1, lines 55-59). Furthermore, Uebelacker does not teach a catalyst in the liquid medium at least in the area surrounding the electrodes to suppress formation of gases and/or recombination of gas to the liquid state.

The Examiner also states that Pavelle et al. teach the use of a catalyst in the

liquid medium at least in the area surrounding the electrodes, which catalyst at least partially suppresses the conversion of the liquid medium into gas and/or converts the gas back to the liquid state.

Applicant respectfully disagree with the Examiner's interpretation of the Pavelle et al. reference. Initially, it should be noted that there is no hint at col. 5, lines 27-67, about a catalyst to suppress formation of gases or recombination of gases into the liquid state. Furthermore, the Pavelle et al. patent is directed to catalytic electrodes. The electrodes used to generate shockwaves for medical uses such as the ones of the present invention are not made of catalytic material. The catalyst is added and dispersed in the liquid medium and is not part of the electrical circuit as in the Pavelle et al. patent. The Examiner's attention is called to col. 2, line 63, wherein there is stated that a conductive dopant may be necessary if the catalyst itself is not a good conductor.

The Pavelle et al. patent is silent on the addition of a catalyst to the liquid medium to prevent formation of gases or to promote recombination of the gases back into the liquid state. It should be noted that in the Pavelle et al. patent the shockwave is used to improve the effectiveness of the catalyst.

The Office has failed to establish the criteria necessary to establish a *prima facie* case of obviousness as set forth in MPEP § 2142: the cited reference must

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teach or suggest all the claim limitations; there must be some motivation or suggestion, either in the reference or in the knowledge available to the skilled artisan, to modify the reference to arrive at the claimed invention, and there must be a reasonable expectation of success. Applicants vigorously disagree with the assertion in the Office Action stating that one skilled in the art would reasonably expect to arrive at the device and method of the present invention. The Office has failed to show where in Pavelle et al. there is a teaching or suggestion of the use of a catalyst dispersed in the liquid medium to prevent formation of gases and/or promote recombination of the gases to the liquid state. It is additionally submitted that Pavelle et al. is deficient in expressly teaching or suggesting the embodiments of the present invention, as recited in the pending claims.

At most, the cited art might give an inference to try to do what Applicants have done. There is usually an element of "obvious to try" in any research endeavor, since such research is not undertaken with complete blindness but with some semblance of a chance of success. However, "obvious to try" is not a valid test of patentability. *Hybritech Inc. v. Monoclonal Antibodies, Inc.* (CAFC 1986) 231 USPQ 81; *In re Geiger* (CAFC 1987) 2 USPQ2d 1276; *In re Dow Chemical* (CAFC 1988) 5 USPQ2d 1529. Patentability determinations based on "obvious to try" are contrary to § 103 of the statute.

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The device and method of the present invention are not obvious because the Pavelle et al. reference does not recognize or suggest the effectiveness of using a catalyst dispersed in the liquid medium to prevent and/or promote recombination of gases formed during the spark gap discharge of the electrodes.

In view of the above remarks, favorable reconsideration and withdrawal of the rejection under 35 USC § 103 is respectfully requested. The Examiner is invited to contact the undersigned at 703-418-2777 if he feels that an interview of the present case would facilitate the resolution of any outstanding issues. An early indication of a Notice of allowance is earnestly solicited.

Respectfully submitted,

Isaac Angres
Reg. 29,765

Filed:

2001 Jefferson Davis Highway
Suite 301
Arlington, VA 22202